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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,138	03/06/2001	Robert Olan Keith JR.	ABREAU-00102	6011
28960	7590	11/16/2004	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			NGUYEN, CAM LINH T	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/801,138

Applicant(s)

KEITH, ROBERT OLAN

Examiner

CamLinh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4 - 15, 17 - 25, 28 - 39, 41 - 49, 52 - 63, 65 - 73, 76 - 87, and 89 - 96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 1, 4 - 15, 17 - 25, 28 - 39, 41 - 49, 52 - 63, 65 - 73, 76 - 87, and 89 - 96.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments to claims 1 - 96 are acknowledged. Consequently, claims 1,15,25,39,49,63,73, and 87 have been amended, claims 2,3,16,26,27,40,50,51,64,74,75, and 88 have been canceled. Accordingly, claims 1,4 - 15, 17 - 25, 28 - 39, 41 - 49, 52 - 63, 65 - 73, 76 - 87, and 89 - 96 are currently pending.
2. Applicant's arguments filed 06/01/04 about Double Patenting rejection have been fully considered but they are not persuasive.

### ***Double Patenting***

1. Claims 1,4 - 15, 17 - 25, 28 - 39, 41 - 49, 52 - 63, 65 - 73, 76 - 87, and 89 - 96 of this application conflict with claims 1 - 40 of Application No. 09/801,072. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,4 – 15, 17 – 25, 28 – 39, 41 – 49, 52 – 63, 65 – 73, 76 – 87, and 89 – 96

provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 40 of copending Application No. 09/801,072 in view of Witek et al (U.S. 6,253,188).

This is a provisional obviousness-type double patenting rejection.

The following table shows the claims in '138 that are rejected by corresponding claims in '072

Claims comparison table

'138	'072
Claims 1, 49, 73, 74	1, 36, 37,
53, 78	5
4, 54,	2
5, 76	3
6, 52, 77	4
7, 55, 79	6, 39,
8, 56, 80	7
9, 57, 81	8, 38
10, 58, 82	9
11, 59, 83	10, 40,

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12, 60, 84	11
13, 61, 85	12
14, 62, 86	13
15, 39, 40, 63, 87,	27
17, 41, 65, 89	28
18, 42, 66, 90	29
19, 43, 67, 91	30
20, 44, 68, 92	31
21, 45, 69, 93	32
22, 46, 70, 94	33
23, 47, 71, 95	34
24, 48, 72, 96	35
25	14
28	18
30	16
31	19
32	20
33	21
34	22
35	23
36	24
37	25

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38	26
39	14 & 27
48	35

According to the amendment filed 06/01/04, Applicant canceled claims 2, 3, 16, 26, 27, 40, 50, 51, 64, 74, 75, and 88. As the result, the scope of claims in the instant application is broadened than the copending application. However, this is not distinct to each other because: it would have been obvious to one with ordinary skill in the art at the time the invention was made to broaden the claims in order to increase the scope of the invention without any cost. It also would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Witek for the missing limitation into the instant application because the combination would provide the user more flexible in searching for information by using different search methodologies.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4 – 15, 17 – 25, 28 – 39, 41 – 49, 52 – 63, 65 – 73, 76 – 87, and 89 – 96, are rejected under 35 U.S.C. 102(e) as being anticipated by Witek et al (U.S. 6,253,188).

♦ As per claim 1, 15, 25, 39, 49, 63, 73, 87,

Witek teaches a method of performing a research task within a searchable database comprising:

- “Utilizing a selective one or more search methodologies including keyword search, hierarchical search...” See Fig. 1, 7,10. In particular:
  - o “A search module” corresponds to the search engine that implemented in Fig. 1.
  - o “A search criteria” corresponds to arguments or selections that user enters in Fig. 7, element 112.
  - o “A searchable database” corresponds to database server (Fig. 1, element 20, col. 9, lines 53 – 55)
  - o “One or more matching items” corresponds to the results that sent to user (Fig. 7, element 126 – 128).
  - o “The search module includes keyword search” See Fig. 10, element 148, col. 29, lines 28 – 34.
  - o “A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 4, col. 31, lines 4 – 11.
  - o “A dichotomous key search” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.
- “A subsequent search” corresponds to a second or third loop of search based on the result. See col. 12, lines 28 – 43.



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- The Examiner takes Official Notice that it is well known for one skill in the art to implement a search module that includes the availability of each search methodologies. “A search module” must be implemented in Witek invention in order for the system to carry out the processing.

◆ As per claim 28, 53, 78,

- “The search module further comprises a parametric search capability” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29.
- “The utilized search methodology is the parametric search, the search criteria is one or more set parameters, and further wherein the parameters are set by a user” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29. As shown in Fig. 10, a user can set the values for parameters such as date, the range price, or number of room.

◆ As per claim 4, 29, 54,

- “The search criteria is one or more keywords input by a user” See Fig. 10, element 148, col. 29, lines 28 – 34.

◆ As per claim 5, 30, 64, 76,

- “The utilized search methodology is the hierarchical search, the search criteria is selected one of a list of one or more directory items” “A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 4, 6 – 7, col. 31, lines 4 – 11.

◆ As per claim 6, 52, 77,

- “The utilized search methodology is the dichotomous key search, the search criteria is a selected one of two binary items” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10,

element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer

(Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.

◆ As per claim 7, 20, 31, 44, 55, 68, 79, 92,

- “The searchable database is distributed into more than one physical location” See Fig. 1, element 20, col. 9, lines 53 – col. 10, lines 5, col. 25, lines 37 – 44.

◆ As per claim 8 – 10, 17 – 19, 32 – 34, 41 – 43, 56 – 58, 65 – 67, 80 – 82, 89 – 91,

- “ The steps of utilizing the search methodologies are performed by a server” See Fig. 1, 5A, col. 25, lines 13 – 33.
- “ Establishing an Internet connection with the server to utilize the search methodologies” See Fig. 5a, element 14, 24, col. 21, lines 15 – 20.

◆ As per claim 11 – 12, 21 – 22, 35 – 36, 45 – 46, 59 – 60, 69 – 70, 83 – 84, 93 – 94,

- “The searchable database is formatted in a directory tree structure” See Fig. 4, col. 18, lines 1 – 32.
- “The directory tree structure includes nodes ... branches” See fig. 4. Each category corresponds to a node. All nodes are linked together.
- “The collection of related data for a particular node is displayed in an encyclopedia like format, wherein the encyclopedia like format includes text, graphics, and links to related topics” See Fig. 8 – 10, col. 23, lines 44 – 48, col. 24, lines 10 – 16.

◆ As per claim 13 – 14, 23 – 24, 37 – 38, 47 – 48, 61 – 62, 71 – 72, 85 – 86, 95 – 96,

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- “Maintaining the node by appropriately adding and deleting data to and from the node”

See col. 50, lines 4 – 15.

- “ The step of maintaining the node is performed by a node owner” See Fig. 14, col. 50, lines 4 – 15. “ A node owner” corresponds to the system administrator.

### ***Response to Arguments***

1. Applicant's arguments filed 06/01/04 have been fully considered but they are not persuasive.

◆ Applicant argues that Witek does not teach a search module that includes a keyword ... such that each utilization of the search module includes the availability of each of these search capabilities” (page 16 of the amendment). The Examiner respectfully disagrees.

Referring to Fig. 10, there are at least four different search methodologies available: parametric, keyword, hierarchical, and dichotomous key search (See the rejection). Witek clearly discloses these search methodologies in the invention.

Referring to Col. 31, lines 1 – 8, Witek teaches that a single parametric can be used to narrow the search result. And at Col. 46, lines 58 – 67, the user is provided with plurality of options for searching the result. The user can start another search (choosing another category) or narrow the current result (setting parameters). “A search module” must be implemented in Witek invention in order for the system to carry out the processing. Clearly, Witek does disclose a search module that includes the availability of each of these search capabilities.

◆ Applicant argues that Witek does not teach a dichotomous key search. The Examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the definition of dichotomous and the way to use it as disclosed on page 18, lines 6 – 10 of the disclosure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As disclosed in the disclosure, an example of dichotomous key search is a yes no answer. Witek also discloses a yes no answer in the form of check box. Therefore, Witek does disclose the dichotomous key search in the invention.

#### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272 - 4024.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272 - 4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cam-Linh Nguyen  
Art Unit 2171

LN



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